In the Supreme Court of the United States

OCTOBER TERM, 1951.

No. 257.

YOUNGS RUBBER CORPORATION,

Petitioner,

vs.

ALLIED LATEX CORPORATION,

Respondent.

PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI.

Petitioner prays that this Court grant rehearing on its Order of October 22d, 1951, denying Petition for Writ of Certiorari, and that a Writ issue to review the Judgment of the Court of Appeals for the Second Circuit in the above cause, as prayed for in the Petition filed August 20, 1951.

REASONS FOR GRANTING REHEARING.

1. A substantial ground available to Petitioner but not previously presented is that in invalidating the patents here involved the Court below acted beyond the powers granted by the Constitution of the United States.

Under Section IX of the Constitution of the United States, which prohibits the passing of *ex post facto* laws, Congress does not have the power to invalidate a patent by a law enacted after issuance of the patent. Likewise the Constitution did not give the Judiciary any power to create *ex post facto* rules and thereon to invalidate a previously granted patent. In other words, a patent is to be judged

according to the statutes and decisions of this Court in force at the time the patent issued and not in accordance with statutes enacted or decisions handed down long after the patents issued.

That the patents here involved are valid under the statutes and decisions of this Court prevailing at the time the patents issued is shown by admissions of the Court below.

The Court below held as to both patents:

> "It is perhaps interesting that an obvious need was not met sooner in this industry and *certainly in old days that would have told strongly in favor of the patent.*" (R 422.)*

and as to the Electrical Test patent held:

> "*Undoubtedly this would have been held invention in times past,* but now the climate of opinion has changed to require definite novelty in idea and not new adaptations of an old idea." (R. 421.)

The patents here involved were invalidated on decisions of this Court, handed down several years after August 27, 1940 and June 3, 1941 when the patents were issued. Those decisions are as follows:

Sinclair & Carroll Co. v. Interchemical Corp., 325 U. S. 327, decided May 21, 1945;

Jungerson v. Ostby & Barton Co., 335 U. S. 560, decided Jan. 3, 1949;

Great Atlantic and Pacific Tea Company v. Supermarket Equipment Corp., 340 U. S. 147, decided Dec. 4, 1950.

In invalidating the patents on those decisions, the Court below misconstrued them so that it appears that it was this Court which had acted beyond the powers granted by the Constitution.

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* Emphasis is ours unless otherwise noted.

The Visual Test patent was held invalid because

> "overwhelming simplicity must always have its effect in contradicting novelty. Great Atlantic & Pacific Tea Company v. Supermarket Equipment Co., 340 U. S. 147." (R. 419.)

This Court has never held that simplicity, whether overwhelming or not, is a ground for holding a patent invalid. Indeed, "startling" simplicity was one of the grounds on which the patent was sustained in the case of *Minerals Separation et al. v. James Hyde*, 242 U. S. 261, where the Court said, on page 268,

> "The simplicity of the operation, as compared with the prior attempts is startling."

This Court did not hold in the foregoing *A. & P.* case that the patent was invalid because of simplicity. On the contrary, the Court held that the patent was invalid because it united

> "old elements with no change in their respective functions," (p. 152).

Moreover, in that case, Mr. Justice Douglas, with whom Mr. Justice Black agreed, said in a concurring opinion,

> "The standard of patentability is a constitutional standard; * * * The question of invention goes back to the constitutional standard in every case." (pp. 155, 6.)

In that case, this Court followed its previous decision in the case of *Williams Manufacturing Co. v. United States Machinery Co.*, 316 U. S. 364, which reiterated previously existing law in the following language:

> "These findings are to the effect that the new combinations, while they involve old mechanical construction, combine these in a new way so as to produce an improved result. * * * The claim that the combinations are merely of old elements, which perform no new

function and produce no new result, must be overruled." (p. 367.)

In holding that

> "the climate of opinion has changed to require definite novelty in idea, and not merely new adaptations of an old idea;"

and that

> "later decisions do not support the plaintiff's reading of directional signals." (R. 421.)

the Court below mistakenly relied on the foregoing *Sinclair & Carroll, Jungerson* and *A. & P.* decisions for they do not support the claim made for them by the Court below. Each decision is based on this Court's decision in *Cuno Engineering Corp. v. Automatic Devices Corporation*, 314 U. S. 84 which reaffirmed the rule as to invention which prevailed at the time the patents in suit were issued. In that case this Court said:

> "Under the statute (35 U. S. C. 31; RS 4886) the device must not only be 'new and useful', it must also be 'an invention' or 'discovery'. * * * if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art." (p. 90.)

The language of this *Cuno* decision was later expanded in the *Sinclair and Carroll* case as follows:

> "A long line of cases has held it to be an essential requirement for the validity of a patent that the subject matter display 'invention', 'more ingenuity * * * than the work of a mechanic skilled in the art'. (Citing many cases) * * * Under this test, some substantial innovation is necessary, an innovation for which society is truly indebted to the efforts of the patentee." (p. 330.)

Thus, the very decisions on which the Court below invalidated the patents in suit established the fact that this Court has never resorted to *ex post facto* rules in invalidating patents but that, on the contrary, it has always been careful not to exceed the powers granted to it by the Constitution. The Court below has exceeded those powers and has ascribed, as authority, decisions of this Court which, as we have seen, are all in strict accord with constitutional provisions.

2. An intervening circumstance of substantial or controlling effect is that the decisions below in this case and in the companion case of *Frank B. Killian & Co. v. Allied Latex Corp.*, 188 F. (2d) 940 have already become established precedents in the Second Circuit.

In the few months since these decisions were handed down, the Courts in the Second Circuit have relied on one or both of them as authority for invalidating patents in at least three cases as follows:

Kleinman v. Betty Dain Creations, Inc., 189 F. (2d) 546;

Landis Machine Co. et al. v. Parker-Kalon Corp. et al., 190 F. (2d) 543;

Van der Horst Corp. of America v. Chromium Corp. of America, 98 F. Supp. 412.

Thus the present decisions have already attained the status of controlling precedents in the Second Circuit and will certainly continue to stand as such precedents unless corrected by this Court.

However, other Circuits have not followed, approved or even cited either of these decision.

Since the decisions in these cases were handed down by the Court of Appeals, the patent bar has become convinced that it has now become impossible to sustain a pat-

ent in the Second Circuit although patents may be sustained in other circuits as heretofore. Accordingly, on the slightest provocation, suit for Declaratory Judgment is brought in the Second Circuit to assure invalidation of the patent involved, but that Circuit is avoided like the plague when it comes to suit for patent infringement. Thus when one patent controversy arises, two nearly concurrent suits result, one for Declaratory Judgment in the Second Circuit, and one for infringement in some other Circuit with the ensuing inevitable interlocutory proceedings in both courts while the parties are jockeying for position.

This is exemplified by the recent decision of *Remington Products Corporation, et al. vs. American Aerovap, Inc.*, 97 Fed. Supp. 644, S. D. N. Y., now on appeal to the Court of Appeals.

This is an intolerable situation which could be corrected with resultant saving of the time and attention of the Federal Judiciary if this Court would bring the Second Circuit into line with this Court and with the other Circuit Courts.

CONCLUSION.

For the foregoing reasons, petitioner respectfully submits that the petition for rehearing should be granted.

BLYTHE D. WATTS,
MORRIS HIRSCH,
Attorneys for Petitioner.

GEORGE H. DESSION,
Of Counsel.

Certificate of Counsel.

I hereby certify that the foregoing Petition for Rehearing is presented in good faith and not for delay and is restricted to grounds specified in Rule 33 of the Rules of this Court.

BLYTHE D. WATTS,
Counsel for Petitioner.

Dated: Cleveland, Ohio.
Nov. 5, 1951.



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CHARLES ELMORE CROPLEY

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

No. 257

YOUNGS RUBBER CORPORATION,
Petitioner,

vs.

ALLIED LATEX CORPORATION,
Respondent.

RESPONSE TO PETITION FOR REHEARING OF ORDER DENYING PETITION FOR WRIT OF CERTIORARI.

Charging that the Court of Appeals, in invalidating the patents in suit, "acted beyond the powers granted by the Constitution of the United States", petitioner invokes Article I, Section 9, of that charter which provides, in its third paragraph, that "No bill of attainder or *ex post facto* law shall be passed". Could it be that the Court of Appeals passed a bill of attainder or an *ex post facto* law? Well, not exactly; but it did "create" an *ex post facto* rule, "thereon to invalidate a previously granted patent"! The invocation of the Fifth and Fourteenth Amendments in the petition for rehearing in the companion *Killian* case was silly enough, but this is even worse—if possible. The *ex post facto* laws proscribed by Article I, Section 9 of the Constitution are criminal and penal laws. *Johannessen* v. *United States*, 225 U. S. 227. Apparently petitioner has never heard of retroactive statutes, which are a commonplace.

As a matter of fact, however, the Court of Appeals did *not* declare the patents in suit invalid on the basis of petitioner's so-called *ex post facto* rule respecting patentable invention. As pointed out at some length in our brief

in opposition to the petition for certiorari, the Court of Appeals held the first patent in suit invalid for lack of novelty, the second for anticipation, and neither for lack of invention, as to which the alleged *ex post facto* rule applies.

But even if the patents *had* been declared invalid for lack of invention, the Court of Appeals would not have been applying an *ex post facto* rule. Petitioner contends that the patents in suit "were invalidated on decisions of this Court, handed down several years after August 27, 1940, and June 3, 1941 when the patents were issued". The decisions referred to are *Sinclair & Carroll Co.* v. *Interchemical Corp.*, 325 U. S. 327, decided May 21, 1945; *Jungersen* v. *Ostby & Barton Co.*, 335 U. S. 560, decided Jan. 3, 1949; and *Great Atlantic and Pacific Tea Company* v. *Supermarket Equipment Corp.*, 340 U. S. 147, decided Dec. 4, 1950. It is interesting to note that if the Court of Appeals acted beyond its constitutional powers in invalidating the patents in suit on the basis of these three decisions because they were handed down "several years after" the invalidated patents had issued, this Court had been equally guilty. Gessler Patent No. 2,087,190 held invalid in the *Sinclair & Carroll* case, issued on July 13, 1937; Jungersen Patent No. 2,118,468, held invalid in the *Jungersen* case, issued on May 24, 1938; and Turnham Patent No. 2,242,408, held invalid in the *A & P* case, issued on May 20, 1941. In short, two of the patents invalidated by this Court in the cited cases were issued several years prior to the patents here in suit and one of them was issued at substantially the same time. And hasn't petitioner overlooked *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, itself decided in 1941 and invalidating a patent issued in 1929?

This whole *ex post facto* argument is absurd. The patent statutes have not been amended since the patents in suit were issued in 1940 and 1941. R. S. 4886 is the same today as it was then. This Court in the cases cited

was applying the statutes as they existed in 1940 and 1941 and earlier. There was nothing *ex post facto* about it. Besides, nobody has a vested right in a judicial decision or in the attitude of the courts. This Court has repeatedly overruled prior decisions. *Neirbo Co.* v. *Bethlehem Shipbuilding Corp.*, 308 U. S. 165. In *Erie R. Co.* v. *Tompkins*, 304 U. S. 64, this Court overruled decisions which began with *Swift* v. *Tyson*, 16 Pet. 1, 10 L. Ed. 865.

Rule 33, 2. of this Court confines the grounds on which a petition for rehearing may be filed "to intervening circumstances of substantial or controlling effect, or to other substantial grounds available to petitioner although not previously presented". Petitioner alleges both. The asserted substantial ground available but not previously presented, *was* previously presented on pages 6, 7, and 8 of the petition for certiorari. Petitioner is advancing the same old argument decked out in a new garb. The "intervening circumstance of substantial or controlling effect" is the citation of the Court of Appeals' decision, twice by itself, and once by the District Court for the Southern District of New York. Well, why not? Petitioner begs the question.

THE PETITION FOR REHEARING IS DEVOID OF MERIT AND SHOULD BE DENIED.

Respectfully,

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November 12, 1951.

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IN THE

Supreme Court of the United States

October Term, 1951.
No. 257.

YOUNGS RUBBER CORPORATION,

Petitioner,

vs.

ALLIED LATEX CORPORATION,

Respondent.

Petition for Leave to File Brief Amicus Curiae on Petition for Writ of Certiorari and Supporting Brief.

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Parker & Company, Law Printers, Los Angeles

IN THE

Supreme Court of the United States

OCTOBER TERM, 1951.

No. 257.

YOUNGS RUBBER CORPORATION,

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Respondent.

Petition for Leave to File Brief Amicus Curiae on Petition for Writ of Certiorari.

To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

Comes now J. Calvin Brown, of the Bar of the United States Supreme Court, and respectfully petitions for leave to file a brief *amicus curiae* on the grounds:

(1) That the decision of the United States Court of Appeals for the Second Circuit in the above entitled case formulates new rules for invalidating patents, which rules are contrary to those applied by this Court and by other Courts of Appeals and which vitally affect the patent system, and

(2) That these newly formulated rules are matters of great public interest and importance to inventors, patent

owners and all members of the publc who make, use or sell patented articles.

Petitioner, *amicus curiae,* is National President of The American Society of Mechanical Engineers, and feels that he would be remiss in his duty if he did not file this petition on behalf of the engineering profession generally and their clients.

The brief for which leave to file is hereby requested, accompanies this Petition.

This Petition is presented in good faith and is filed solely in what is believed to be the public interest. Petitioner does not represent any of the parties hereto nor has he any interest in the specific subject matter of the suit.

J. Calvin Brown,
Petitioner, Amicus Curiae.

IN THE

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OCTOBER TERM, 1951.

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YOUNGS RUBBER CORPORATION,

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Respondent.

Brief Amicus Curiae on Petition for Writ of Certiorari.

In its decision in the above entitled case (188 F. 2d 945), the Court of Appeals for the Second Circuit held at page 948:

> "It will thus be seen that the patentees took one of the oldest of electrical conceptions and adapted it rather ingeniously to a particular need of this business. Undoubtedly this would have been held invention in times past, *but now the climate of opinion has changed to require definite novelty in idea, and not merely new adaptations of an old idea."**

*Emphasis supplied.

This holding seems to be in direct derogation of the statute 35 U. S. C. 31; R. S. 4886, which provides in part:

> "Any person who has invented or discovered any new or useful art, machine, manufacture, or composition of matter, or *any new and useful improvements thereof,* * * * may * * * obtain a patent therefor."

If a patent to be valid must embody "definite novelty in idea," no improvements can be validly patented. Such a rule, if permitted to stand, would effectively nullify the portion of the statute dealing with improvement patents and would make it impossible for any improvement patents to be sustained hereafter in the Second Circuit.

It has never been the rule in this Court that a patent to be valid must embody "definite novelty in idea, and not merely new adaptations of an old idea." On the contrary, practically every patent sustained by the Supreme Court has belonged to the class of improvement patents wherein adaptations of old ideas alone are involved. Patents which comply with the requirements of the foregoing new rule can probably be counted on the fingers of one hand.

The question of law involved in the above stated new rule has never before been raised, is of vital importance to all persons and companies having to do with inventions and patents and is a direct challenge to the statutes. It should be decided by this Court.

For these reasons, it is urged that the Petition for Writ of Certiorari be granted.

J. Calvin Brown,

Petitioner, Amicus Curiae.

September 20, 1951.

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CLERK

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1951

No. 257

YOUNGS RUBBER CORPORATION,
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Respondent.

RESPONDENT'S OBJECTION TO THE FILING OF A BRIEF AS AMICUS CURIAE BY J. CALVIN BROWN.

Mr. J. Calvin Brown of Los Angeles, California, has filed a petition for leave to file a brief as *amicus curiae* in support of the petition for a writ of certiorari herein, and appends to his petition the brief he would like to file. Respondent's consent was not asked but would have been refused in any case for the following reasons:

As pointed out in our objection to the filing of an *amicus* brief in the companion *Killian* case, Mr. Brown, appearing as an individual, arrogates to himself the right to speak "on behalf of the engineering profession generally and their clients", but fails to present his credentials as the authorized spokesman for this large body of citizens. He also identifies himself as "National President of The American Society of Mechanical Engineers", and thereby seeks to give the impression that he is authorized to speak in its behalf. But here again no credentials are presented and Mr. Brown's views must, therefore, be considered as merely his own.

As in his petition in the companion *Killian* case, Mr. Brown makes no attempt to comply with the provision of this Court's Rule 27, 9 (c) requiring that one seeking to file an *amicus* brief when consent has been refused shall

> "set forth facts or questions of law that have not been, or reasons for believing that they will not adequately be, presented by the parties".

The only point made by Mr. Brown in his proposed brief is that the Court of Appeals erred in writing of the Electrical Test Patent:

> "Undoubtedly this would have been held invention in times past, *but now the climate of opinion has changed to require definite novelty in idea, and not merely new adaptations of an old idea.*"

This same sentence was quoted on page 6 of the petition for certiorari and criticized on pages 7 and 8. The burden of petitioner's argument was that the Court of Appeals had magnified and distorted recent decisions of this Court on invention. Mr. Brown now says that the quoted statement "seems to be in direct derogation of the statute, 35 U. S. C. 31; R. S. 4886", and "a direct challenge" to it, which is very much the same argument.

The answer to both petitioner and Mr. Brown is found on pages 9 and 10 of respondent's brief in opposition: that the claims in suit of the Electrical Test Patent were *not* held invalid for lack of invention, but for "anticipation", which is not the same thing, so that "the climate of opinion" with respect to invention, whether changing or not, had nothing to do with the ultimate decision. Moreover, it is clear that the Court of Appeals, in the quoted passage, was doing no more than restating the law as defined by this Court in numerous decisions.

THE PETITION FOR LEAVE TO FILE A BRIEF AS AMICUS CURIAE SHOULD BE DENIED.

Respectfully,

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